

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas Zelinski et al.

Application No.: 10/541,427

Confirmation No.: 6584

Filed: July 5, 2005

Art Unit: 1651

For: METHODS FOR PRESERVING AND/OR
STORING CELLS HAVING A NITRILASE OR
NITRILE HYDRATASE ACTIVITY

Examiner: Hanley, Susan Marie

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed January 3, 2008, Applicants provisionally elect Group I, claims 14-21, 23 and 25-26, the microorganism *Alcaligenes* (for claim 20), and fine chemicals (for claims 25-26), with traverse. Applicants respectfully traverse and strongly urge reconsideration and withdrawal of the restriction requirement for the following reasons.

Because this application is a national stage filing pursuant to 35 U.S.C. § 371, unity of invention under PCT Rule 13.1 and 13.2 is the applicable standard. Unity of invention is fulfilled "when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical feature. The expression 'special technical feature' shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." (PCT Rule 13.2).

The Examiner alleges that Groups I, III and IV lack unity because the technical feature linking the claims does not make a contribution over the prior art, citing Kobayashi *et al.* (Eur. J. Biochem., 1989, 182:349-356, hereinafter "Kobayashi"). The Examiner argues that Kobayashi discloses that *Rhodococcus rhodococcus* J1 has nitrilase activity and produces nicotinic acid.

The Examiner further alleges that nicotinic acid is a pharmaceutical agent, and thus, Kobayashi teaches the special technical feature of the invention of Group III, *i.e.* a pharmaceutical agent irrespective of its source. The Examiner concludes that, because those claimed embodiments fail to make a contribution over the prior art, all claims as filed fail to provide a special technical feature common to all claimed inventions. Therefore, Group III lacks unity with Groups I and IV. Applicants respectfully disagree with the Examiner's characterization of the special technical feature common to all claims of Groups I, III and IV and the reasoning in finding lack of unity.

As stated in the specification and repeated in the claims, the invention relates to a method for preserving and/or storing microorganisms which exhibit at least one nitrilase enzyme activity. See Specification at page 1 and claim 1. Thus, the common technical feature shared by all claims of Groups I-IV is preserving and/or storing a microorganism which exhibits at least one nitrilase enzyme activity. As the Examiner correctly characterized, Kobayashi discloses that *Rhodococcus rhodococcus* J1 has nitrilase activity and produces nicotinic acid. Nevertheless, Kobayashi does not teach a method for preserving and/or storing microorganisms which exhibit at least one nitrilase enzyme activity. Thus, Kobayashi does not teach the special common technical feature of the present application. The Patent Office has not established the presence in the prior art of Applicants' invention as claimed. Therefore, pursuant to PCT Rule 13.2, there is no lack of unity since the special technical feature defines a contribution which the claimed invention makes over the reference cited by the Examiner.

The Examiner further alleges that Groups II and III lack a common technical feature because the single isolated compound in Group III (e.g., feedstuff) is not structurally related to and has different uses compared to the compounds in a solution of Group II (i.e. aldehyde and cyanide). Furthermore, the Examiner argues that Groups I, II and IV lack a common technical feature because these Groups comprise products and methods having very different properties, purposes and uses. Additionally, the Examiner alleges that Group I lacks unity with Group IV because these Groups are drawn to different methods. The Examiner has used the rational applicable to restriction practice and not the required standard under unity of invention that the inventions be "so linked as to form a single general inventive concept."

As discussed above, the general inventive concept of the present application relates to a method for preserving and/or storing microorganisms which exhibit at least one nitrilase enzyme

activity. See Specification at page 1 and claim 1. The claims of Groups I-IV all relate to this general inventive concept of preserving and/or storing microorganisms which exhibit at least one nitrilase enzyme activity. Applicants submit that the claims of Groups I-IV are so linked as to form a single general inventive concept. Therefore, these claims should be considered together based on unity of invention, and could be examined together with minimal burden.

Additionally, Applicants believe that there is no undue burden on the Examiner to search and examine all Groups together. As stated in § 803 of the M.P.E.P. “[i]f the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.” (M.P.E.P. § 803, emphasis added). As discussed above, the claims of Groups I-IV share a common technical feature of preserving and/or storing microorganisms which exhibit at least one nitrilase enzyme activity. The same art and field of search relevant to a method or a preparation for preserving and/or storing microorganisms which exhibit at least one nitrilase enzyme activity would be also relevant to a product derived from such preparation or a method for preparing another product using such preparation.

Alternatively, it is respectfully requested that at least the claims of Groups I and II be examined together because the claim of Group II merely discloses measures to perform the method of Group I, and therefore, it would not be burdensome to consider two Groups together.

For these reasons, Applicants respectfully request that the Examiner reconsider the restriction requirement and examine all the claims in one application. Alternatively, it is respectfully requested that the claims of Groups I and II be examined together in one application.

The International Examiner Found Unity of Invention

Furthermore, unity of invention was found during the International stage. As shown in the International Preliminary Examination Report and International Search Report, all claims were searched and examined together. Thus, application of PCT Rules 13.1 and 13.2 by the International Examiners shows that unity exists. Since the search has already been conducted by the International Search Authority and the International Examination Authority and no lack of unity of invention has been found, for this additional reason, there would be no undue burden on the Examiner to examine all Groups in one application.